

Appl. No. 10/693,584
Amdt. dated March 13, 2006
Reply to Office Action of November 15, 2005

REMARKS

Restriction Requirement

Applicant confirms the election of claims 1-17. Claims 18-33 are withdrawn and may be rejoined in the present application upon finding of allowable subject matter.

Summary of Office Action

1. The Abstract of the disclosure was objected to.
2. Claims 1-17 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 27 of copending Application No. 10/692,827. The Examiner asserted that the claims are not patentably distinct from each other because the conflicting claims are merely to overlapping species of each other.
3. Claims 1-17 were rejected under 35 U.S.C. 112, second paragraph.
4. Claims 1-10, 12 and 13 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,323,353 ("Sumi"). The Examiner asserted that Sumi disclosed the claimed invention.
5. Claims 1-17 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,307,087 ("Buchwald"). Again, the Examiner asserted that Buchwald disclosed the claimed invention.

Response

1. A new Abstract is submitted to replace the objected to Abstract of the Disclosure.

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2. Regarding the provisional double patenting rejection, Applicant respectfully requests that, since Application No. 10/692,827 ("the '827 application") has not been allowed and has the same filing date as the present application, the present application be allowed first and any issue of double patenting be substantively raised in the '827 application. Alternatively, Applicant may consider a filing of a Terminal Disclaimer if the rejections under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 102 are withdrawn in the next Office Action.

3. Regarding the rejection of claims 1-17 under 35 U.S.C. 112, second paragraph, some of the claims have been amended to overcome the rejection. Applicant wishes to provide the following responses where no amendment is made.

Regarding the Examiner's comment on the term "Y" in claims 1, 2, and 14-16, Applicant respectfully submits that a person of ordinary skill in the art would clearly understand that the term "Y," recited in the claims, refers to a hydrocarbyl bridge, not yttrium. In fact, the term "Y" is clearly defined in the specification, e.g. in line 10, page 2 of the specification. Therefore, withdrawal of the rejection with respect to "Y" in the claims is respectfully requested.

Regarding the Examiner's comment that claim 1 does not clearly recite how X or Y are bound to its respective group, Applicant respectfully submits that claim 1 recites an open transitional term "comprising" when referring to the composition of matter. Such composition of matter comprises X and Y. A more detailed recitation regarding how the X and Y are bound to its respective group is provided in dependent claims which narrow the independent claim 1.

Regarding the Examiner's comment that (a-c) and (e) fail to further limit the claim,

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Applicant again respectfully disagrees. Claim 2 provides a formula to further limit the composition of matter and (a-c) and (e) further define the limited formula. A person of ordinary skill in the art would understand that claim 2 further limits claim 1.

Regarding the Examiner's comments that the last two members of the Markush group in Claim 6 lacks antecedent bases in claim 5, Applicant again respectfully disagrees. The two members in claim 6 were clearly recited in claim 5.

Regarding the Examiner's comments on claim 9 that the term "amino" should be "amido," Applicant respectfully disagrees, as the term amino is used throughout the specification.

Regarding the Examiner's comments that claim 12 does not further limit claim 2, Applicant respectfully disagrees because a metal from Groups 8-10 is a broader term than the specific metals recited in claim 12.

Regarding the Examiner's comments that recited groups of "A" in claims 16 and 17 contradict claims 1 and 2, Applicant respectfully submits that Y, the hydrocarbyl bridge as recited in claims 1 and 2, and A are not the same groups.

4. Regarding the rejection of claims 1-10, 12 and 13 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,323,353 ("Sumi"), this rejection is respectfully traversed.

As the Examiner is well aware, in order to anticipate a claim, the cited document must contain each and every recitation of the rejected claims. Applicant respectfully submits that Sumi fails to disclose each and every recitation of the claims.

The Office Action alleges that various descriptions of Sumi disclose the claimed invention.

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Upon a close review of the mentioned descriptions of Sumi, none of these descriptions discloses the inventions as claimed. At least one difference between the Sumi descriptions, as mentioned by the Examiner, and the present claims are provided below:

Abstract of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 2, line 55 to Col. 3, line 40 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 4, line 1-12 and line 45-57 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 10, line 20 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 11, line 55 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 12, line 20 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 13, line 35 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 14, line 50 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Col. 17 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

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Example 14 of Sumi: there is no disclosure of an abstractable ligand, X, as defined and claimed in the present application.

Claims 1, 2, and 21 of Sumi: the formula disclosed contains a double bond connecting O and P and there is no disclosure that n is zero. In other words, the formula claimed in Sumi contains a double bond connecting O which is not the same ancillary ligand as recited and claimed in the present application.

Because of the difference of the alleged anticipatory disclosure and the present claimed invention, Sumi does not anticipate claims 1-10, 12 and 13 and the rejection should be withdrawn.

5. Regarding the rejection of claims 1-17 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,307,087 ("Buchwald"), this rejection is also respectfully traversed.

Again, in order to anticipate a claim, the cited document must disclose each and every recitation of the rejected claims. Applicant again respectfully submits that Buchwald fails to anticipate claims 1-17.

The Office Action cites various sections of Buchwald for the alleged teaching of the invention as claimed in claim 1-17. Upon a close reading of these alleged teachings, they are not the same as the present invention. For example, none of the alleged teachings of Buchwald discloses an abstractable ligand, X, of the present invention. Therefore, Buchwald fails to disclose each and every recitation of claims 1-17 and the rejection should be withdrawn.

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CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

March 13, 2006
Date

Respectfully submitted,

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